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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITCHELL D. EGGERS

Appeal 2008-2172
Application 10/007,355
Technology Center 1700

Decided: December 29, 2008

Before BRADLEY R. GARRIS, CHARLES F. WARREN, and KAREN M. HASTINGS, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 40 and 58 through 69 in the Office Action mailed December 8, 2005 (Office Action). 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

We affirm the decision of the Primary Examiner.

Claim 1 illustrates Appellant's invention of a sample carrier, and is representative of the claims on appeal:

1. A sample carrier comprising:

a structural array; and

a plurality of discrete sample nodes; each of said plurality of discrete sample nodes being removably attached to said structural array at a respective attachment point and comprising a sample support medium operative to carry a discrete sample in desiccated form.

The Examiner relies upon the evidence in these references (Ans. 3): [1]

Milosavijevic	WO 01/31333 A1	May 3, 2001
Hogan	WO 01/31317 A1	May 3, 2001

Appellant requests review of the ground of rejection under 35 U.S.C. § 102(e) advanced on appeal by the Examiner:

claims 1 through 40 and 58 through 69 as anticipated by Milosavijevic; and

claims 1 through 14, 20 through 35, 58 through 66, and 69 as anticipated by Hogan. App. Br. 5; Ans. 4 and 5.

The Examiner also advances the following grounds of rejection on appeal:

claims 1 through 40 and 58 through 69 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the specified claims of co-pending Applications 10/005,529, 10/150,770, and 10/150,771 (Ans. 2); and

claims 15 through 19, 36 through 40, 67, and 68 under 35 U.S.C. § 103(a) over Hogan (Ans. 6).

The dispositive issue in this appeal with respect to the grounds of rejection under § 102(e) is whether Appellant has established that neither

[1] We consider these documents: Appeal Brief filed June 4, 2007; Examiner's Answer mailed August 17, 2007; and Response To Order Requiring Additional Briefing By Appellant filed September 19, 2008.

Milosavijevic nor Hogan describe to one skilled in this art an embodiment of a sample carrier comprising at least, among other things, "discreet sample nodes being removably attached to said structural array at a respective attachment point" as claimed.

We determine the plain language of representative independent claim 1 specifies a sample carrier comprising at least, among other things, "a plurality of discrete sample nodes" each of which is "removably attached to" a "structural array at a respective attachment point." Accordingly, each sample node is a separate entity and is separately attached at a specific location in removable manner to any manner of structural array, as Appellant contends. Br., e.g., 6-9, citing Spec., e.g., 28:1-30 and 31:24 to 32:11, and Figs. 4A and 5A-C.

We find Milosavijevic would have disclosed to one of ordinary skill in this art a method for requesting genomics services from a provider over the internet wherein the service provider applies, among other things, DNA samples stored on cards in a DNA Repository to microarrays containing identified genomic sequences. Milosavijevic, e.g., Abstract and 16:1 to 18:27. "[A]utomated equipment such as robotics may be used to selected and obtain the corresponding DNA sample and provide the sample to the microarray for interrogation." Milosavijevic 18:6-10. "A microarray consists of an array of test sites formed on a suitable structure." Milosavijevic 16:21-22; *see* 16:22-23 and Fig. 5. "A sample containing an unknown candidate molecule, such as a DNA molecule . . . is hybridized to the microarray containing the capture probe." Milosavijevic 16:24-26.

We find Hogan would have disclosed to one of ordinary skill in this art a retrieval system using robotics to retrieve DNA specimens from a repository and punching or otherwise removing small samples, such as a pellet, from each specimen, and depositing the sample in one well of a multiwell tray for processing. Hogan, e.g., abstract, 1:20 to 2:29, 3:22-25, and Fig. 1. Hogan illustrates with an embodiment in which "a slide 22 includes a flexible substrate 24 on which a biological specimen 26 has been deposited," wherein "flexible substrate 24 is contained in a relatively rigid frame 27." Hogan 3:26 to 4:18 and Fig. 2. "[T]he flexible substrate 24 may be sized to provide a number of pellets," such that "a slide may be punched up to a number of times." Hogan 6:4-10 and Figs. 3-5. "As shown in FIGS. 2 and 4, the sample contains outlines for illustrative purposes only of 96 circular pellets 100," and [o]bviously, each pellet may be differently sized or shaped depending on the shape of the tip 42 of the punch head." Hogan 6:10-12 and Figs. 2-5.

The Examiner takes the positions that"[t]he claimed nodes . . . read on the sample applied to the substrate (24) and the claimed array on the taught multi-well tray," as stated with respect to Hogan, and that each of the references "teach punching out a dried biological sample from a discrete portion of the sheet" containing the sample. Ans. 4 and 8.

We agree with Appellant that, contrary to the Examiner's position, the tested sample is not "discrete" until it is removed from the sample card, at which point the tested sample is not "removably attached" to a "structural array." Br. 6-9. Accordingly, as a matter of fact, each and every limitation of the claimed sample carrier encompassed by representative independent

claim 1, arranged as required therein, does not read on embodiments described in Milosavijevic and in Hogan. *See, e.g.*, *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997), and cases cited therein; *In re Spada*, 911 F.2d 705, 707 (Fed. Cir. 1990).

Accordingly, Appellant has established that neither Milosavijevic nor Hogan describe to one skilled in this art an embodiment of a sample carrier falling within representative claim 1. In the absence of a prima facie case of anticipation, we reverse each of the grounds of rejection under 35 U.S.C. § 102(e).

We summarily affirm the provisional ground of rejection of claims 1 through 40 and 58 through 69 under the judicially created doctrine of obviousness-type double patenting, and the ground of rejection of claims 15 through 19, 36 through 40, 67, and 68 under 35 U.S.C. § 103(a) over Hogan. Each of these grounds of rejection was advanced on appeal by the Examiner and Appellant did not request review of either of these grounds (*see above* p. 2). *See* Manual of Patent Examining Procedure § 1205.02 (8th ed., Rev. 3, August 2005) ("If a ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.").

The Primary Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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